

### **REMARKS/ARGUMENTS**

Reconsideration of this Application and entry of this Amendment is respectfully requested. Applicants acknowledge the statements in the office action regarding elections, the IDS, and the drawings in the current application. Claims 1, 3, and 6 have been amended and claims 1-11 remain in the application for examination. The remainder of the original claims have either been cancelled or withdrawn from examination. The cancellation of any claim should not be construed as an admission as to the patentability of that particular claim. Applicants believe that the amendments to the claims do not add any new matter to the application, and support for those amendments can be found in the specification. The proposed amendments address items brought up in the office action. In view of the amendments and following remarks, favorable consideration and allowance of the application is respectfully requested.

#### **35 U.S.C. § 112 Rejections**

Claim 6 was rejected under 35 U.S.C. § 112 for insufficient antecedent basis for the limitation of “the at least one deformation element.” The office action noted that there would be proper antecedent basis for that element if claim 6 depended from claim 5, instead of claim 1. Applicants have amended claim 6 to depend from claim 5, and respectfully request that the rejection of claim 6 under 35 U.S.C. § 112 be withdrawn.

#### **35 U.S.C. § 102 Rejections**

Of the currently pending claims, claims 1, 2, 4, 8, 10, and 11 were rejected under 35 U.S.C. §102(b) as being anticipated by US Pat. No. 6,348,064 to Kanner (hereinafter Kanner). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.1987). The identical invention must be shown in as complete detail as is contained in the . . . claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir.1989). Thus, to warrant the 35 U.S.C. §102(b) rejections, the references cited in the office action must show each and

every limitation of the claims in complete detail. The Applicants respectfully assert that the cited art fails to include each and every element of the Applicants' claimed invention, as required to maintain a rejection under 35 U.S.C. §102(b). *See* MPEP 2131.

Specifically, Kanner does not disclose a device having legs wherein each leg further includes a bistable snap-acting spring tip. The bistable tips of applicants legs each have two stable states that are separate from the deployment state and a treatment state of the legs of the device disclosed in the current application. Applicants have amended their claims to better point out the novelty of their invention over Kanner, and the support for this amendment (including a description of the two stable states of the bistable tips) can be found in ¶¶ 27-31 of the current application.

Conversely, the tips of the devices described in Kanner do not have different states at all, let alone separate from the deployment state and treatment state of the legs. Instead, the devices of Kanner have tips with a permanent hook shape such that the tips secure tissue when the legs of the devices are moved to a treatment state. Because Kanner does not disclose devices having legs that include a bistable snap-acting spring tips, Applicants respectfully request that the rejection of their claims, under 35 U.S.C. §102(b), be withdrawn.

### **35 U.S.C. §103 Rejections**

Of the currently pending claims, claims 3, 5-7, and 9 were rejected under 35 U.S.C. §103(a) as being obvious based on combinations of art cited in the Office Action. The rejections are traversed. First, none of the combinations of prior art include devices with legs having bistable snap-acting spring tips. Applicants have amended their claims and respectfully request that the rejections under 35 U.S.C. §103(a) be withdrawn based on the amendment.

Additionally, all of the obviousness rejections under 35 U.S.C. §103(a) in the office action are improper because all of the rejected claims depend from claims that were not rejected as obvious under 35 U.S.C. §103. Where an independent claim is non-obvious, any claim depending therefrom is also non-obvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). *See*, MPEP 2143.03. Applicants respectfully request that the rejections under 35 U.S.C. §103 be withdrawn because all of the rejected claims depend from claims that were not found to be obvious.

### **CONCLUSION**

For the foregoing reasons, Applicant believes all the pending claims are in condition for allowance and should be passed to issue. The Commissioner is hereby authorized to charge any additional fees which may be required under 37 C.F.R. 1.17, or credit any overpayment, to Deposit Account No. 01-2525. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at telephone (707) 543-5484.

Respectfully submitted,

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